

REMARKS

In the Office Action mailed August 26, 2004, claims 1-27, and 29-35 were rejected under 35 U.S.C. 112, first paragraph. Next, claims 14 and 27-35 were rejected under 35 U.S.C. 112, second paragraph. Next, claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,879,419 to Johannessen (hereinafter "Johannessen"). Next, claims 1 and 3-6 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,910,559 to Rahman et al. (hereinafter "Rahman"). Next, claims 1, 3, and 5-7 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,630,568 to Johnson et al. (hereinafter "Johnson"). Next, claims 10-11, 16-20 and 22-26 were rejected under 35 U.S.C. 102(e) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson. Next, claims 12-15, 27, and 29-35 were rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson. Next, claims 12-15, 27, and 29-35 were rejected under 35 U.S.C. 103(a) as being obvious over Johnson in combination with U.S. Patent No. 6,235,866 to Khouri et al. (hereinafter "Khouri"). Finally, claim 28 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 10, 13, 14, and 28-35 have been amended, claims 1-9, 18, 21, and 27 have been cancelled, and claims 10-17, 19, 20, 22-26 and 28-35 remain active in the application. No new matter has been added.

Claim 28 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 28 has been rewritten in independent form to include all the limitations of the base claim and any intervening claims. Thus, the objection to claim 28 should now be withdrawn. Claims 29-35 have been amended to depend directly or indirectly from claim 28. Thus, claims 29-35 are therefore believed to also be allowable for the reasons set forth above.

First, claims 1-27 and 29-35 were rejected under 35 U.S.C. 112, first paragraph. The Examiner states on page 3, first paragraph, "The only claim that currently claims solvent/antisolvent combinations for which the specification is fully enabling is claim 28." It is respectfully submitted that claims 1-9, 18, 21, and 27 have been cancelled, thereby rendering the rejection of claims 1-9, 18, 21, and 27 under 35 U.S.C. 112, first paragraph, moot.

With regard to claims 10-17, 19, 20, and 22-26, claim 10 has been amended to recite, in part, the limitations of claims 18 and 21: "a solvent selected from the group consisting of o-dichlorobenzene and anisole" and "an anti-solvent selected from the group consisting of toluene, ketones, acetone, tetrahydrofuran, xylenes, and dioxane". Claim 10 should now be in condition for allowance and the rejection under 35 U.S.C. 112, first paragraph should now be withdrawn and rendered moot. Furthermore, claims 11-17, 19, 20, and 22-26 depend either directly or indirectly from independent claim 10 and are therefore believed to also be allowable for the reason set forth above.

With regard to claims 29-35, claims 29-35 have been amended to depend either directly or indirectly from amended independent claim 28. Hence, the rejection under 35 U.S.C. 112, first paragraph of claims 29-35 should now be withdrawn.

Next, claims 14 and 27-35 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

The Examiner states that with regards to claim 14, "Applicants are requested to provide clarification whether claim 14 is missing a step of further reaction the imide with dihydroxy-monomer, or it only results in formation of imide, or it should depend on claims 12 or 13." Claim 14 has been amended to depend upon claim 13. Hence, claim 14 should now be in condition for allowance and the rejection under 35 U.S.C. 112, second paragraph should now be withdrawn.

The Examiner states that with regards to claim 27, "Applicants are required to provide clarification whether the halophthalimide is pre-reacted with another compound

prior to reaction with bisphenol A disodium salt or the halophthalimide is directly reaction with bisphenol A disodium salt.” Claim 27 has been cancelled, hence the rejection under 35 U.S.C. 112, second paragraph should now be rendered moot. Additionally, with regards to claim 28-35, the amendments to claims 28-35 omit the terminology that the Examiner cites as being indefinite thereby obviating the basis for the rejection. Thus, claims 28-35 should now be in condition for allowance and the rejections under 35 U.S.C. 112, second paragraph should now be withdrawn and rendered moot.

Next, claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,879,419 to Johannessen, claims 1 and 3-6 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,910,559 to Rahman, and claims 1, 3, and 5-7 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,630,568 to Johnson. As stated earlier, claims 1-9 have been cancelled, thereby rendering their rejection under 35 U.S.C. 102(b) and 102(e) moot.

Next, claims 10-11, 16-20 and 22-26 were rejected under 35 U.S.C. 102(e) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson. It is submitted that this rejection is not applicable to any claim presently in the application. As stated earlier, claim 10 has been amended to include the limitations of dependent claim 18 and 21. Hence, the rejection of claims 10-11, 16-20, and 22-26 should now be withdrawn and rendered moot.

Next, claims 12-15, 27, and 29-35 were rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson. It is submitted that this rejection is not applicable to any claim presently in the application. Claims 12-15 depend either directly or indirectly upon independent claim 10 which now includes the limitations of dependent claims 18 and 21. Claim 27 has been cancelled thereby rendering its rejection moot. Claims 29-35 depend either directly or indirectly upon allowable independent claim 28. Hence, the rejection of claims 12-15 and 29-35 should now be withdrawn and rendered moot.

Appln. No. 10/647,678
Amd. dated December 13, 2004
Reply to Office Action of September 15, 2004

Next, claims 12-15, 27, and 29-35 were rejected under 35 U.S.C. 103(a) as being obvious over Johnson in combination with U.S. Patent No. 6,235,866 to Khouri. It is submitted that this rejection is not applicable to any claim presently in the application. Claims 12-15 depend either directly or indirectly upon independent claim 10 which now includes the limitations of dependent claims 18 and 21. Claim 27 has been cancelled thereby rendering its rejection moot. Claims 29-35 depend either directly or indirectly upon allowable independent claim 28. Hence, the rejection of claims 12-15 and 29-35 should now be withdrawn and rendered moot.

In view of the foregoing amendment and for the reasons set out above, it is respectfully submitted that claims 10-17, 19, 20, 22-26 and 28-35 which stand rejected in this application, are now in condition for allowance. Favorable action on these claims is requested.

Respectfully submitted,



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